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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,026	11/07/2001	Hiroyuki Kishi	1506.1013	4741

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EXAMINER

HO, THOMAS Y

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/986,026

Applicant(s)

KISHI, HIROYUKI

Examiner

Thomas Y Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of the claims*

Claims 1-17 are pending. No claims have been cancelled.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-2, 6-8, 11-12, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwab US20020019777.**

As to claim 1, Schwab discloses, a purchase information collecting method for collecting information on a purchaser (a customer) of one or more commodities (any products) using a network (the Internet; [0008]) with a server apparatus 401, the method comprising: receiving a first sales information (a return certification), which identifies a deal (valid purchase information) about of a first commodity (one of any number of items), from a seller (a merchant) of the first commodity, wherein the first sales information is generated by the seller of the first commodity ([0059]-[0061]); storing the received first sales information in a first storing part (the first storing part is any computer memory); receiving purchase information (a return certification), which comprises personal information ([0061]) of a purchaser (a customer) of a second commodity (another of any number of items) and a second sales information, from the purchaser of the second commodity, wherein the second sales information is presented to the

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purchaser by a seller of the second commodity (the return certification is created by the merchant and sent to the purchaser); judging whether the second sales information included in the received purchase information is stored in said first storing part (the judging step corresponds to validation); and if the second sales information is stored in the first storing part (valid return certification information), storing the received purchase information as valid purchase information in a second storing part (if the return certification is valid, the purchase is valid, and a second storing part is any computer memory that transmits or recognizes the corresponding information).

As to claim 2, Schwab discloses, wherein the purchase information further comprises: first information for identifying the seller of the second commodity ([0061]); second information for identifying a deal (435 in Figure 9) made by the seller of the second commodity; and third information for identifying the second commodity.

As to claim 6, Schwab discloses, further comprising transmitting to a computer operated by the purchaser a screen data that makes a browser program executed in the computer to display a screen containing an input area for inputting the purchase information and an item for inputting an instruction to submit the purchase information in the input area to said server apparatus (the computer is actually located at the third party, but it used together by the purchaser and the third party clerk; [0011]).

As to claim 7, Schwab discloses, a purchase information collecting program causing a computer (merchant computer) capable of communicating with other computers (third party computers) to perform processing comprising: receiving a first sales information (a return certification), which identifies a deal of a first commodity from a seller of the first commodity,

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wherein the first sales information is generated by the seller of the first commodity (seller generates the return certification and encodes it); storing the received first sales information in a first storing part (the first storing part is any computer memory that stores the return certification info, including memory holding the authentication/recognition information); receiving purchase information (receiving a printed return certification from a customer upon returning an item), which comprises personal information of a purchaser of a second commodity and a second sales information, from the purchaser of the second commodity, wherein the second sales information is presented to the purchaser by a seller of the second commodity (the return certification was mailed to the customer with the product); and storing, when the second sales information included in the received purchase information is stored in said first storing part, the received purchase information as valid purchase information in a second storing part (if the return certification is recognized as valid, the product will be recognized as a valid purchase and a message will be sent electronically to the third party; any memory that holds/recognizes/displays this message is a storing part).

As to claim 8, Schwab discloses, wherein the purchase information further comprises: first information for identifying the seller of the second commodity; second information for identifying a deal made by the seller of the second commodity; and third information for identifying the second commodity (see Figure 9, 435 and also [0061]).

As to claim 11, Schwab discloses, a purchase information collecting method for collecting a deal between a purchaser and a seller, comprising: receiving first deal identifying information from a seller (creating an encrypted return certification; [0009]); storing the first deal identifying information in a first storing part ([0009]; a database of executed transactions);

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receiving second deal identifying information (receiving a return certification when a customer makes a return to a third party establishment) and personal information from a purchaser; and comparing the second deal identifying information and the first deal identifying information stored in said first storing part (comparing indicates a validation step; [0009]).

As to claim 12, Schwab discloses, further comprising: storing, when an equal comparison is made, the second deal identifying information and the personal information in a second storing part (when the return certification is valid, a message/parameters are sent concerning the purchase, and computer memory that receives or recognizes this is a storing part).

As to claim 16, Schwab discloses, a purchase information collecting program causing a computer to perform processing comprising: receiving first deal identifying information from a seller (creating a return certification and information for an executed transactions database [0009]); storing the first deal identifying information in a first storing part (storing information in an executed transactions database [0009]); receiving second deal identifying information and personal information from a purchaser (receiving an encoded return certification from a customer); and comparing the second deal identifying information and the first deal identifying information stored in said first storing part (validating the information for authenticity against the executed transactions database).

As to claim 17, Schwab discloses, a purchase information collecting apparatus for collecting information on a deal between a purchaser and a seller, comprising: a unit that receives first deal identifying information from a seller (the unit is a manufacturer computer); a unit that stores the first deal identifying information in a first storing part (the first storing part is an executed transactions database); a unit that receives second deal identifying information (a

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third party computer receives/inputs a return certification) and personal information from a purchaser; and a unit that compares the second deal identifying information and the first deal identifying information stored in said first storing part (the server validates the return certification against a database to determine validity).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3-5, 9-10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab US20020019777 in view of Rogers US5978774.**

As to claim 3, Schwab discloses, wherein the second information included in the purchase information indicates a date order of deals made by the seller of the second commodity identified with the first information. Rogers discloses a return validation method similar to that of Schwab. In addition, Rogers further teaches to include a date and time. It would have been obvious to one of ordinary skill in the art, having the disclosures of Schwab and Rogers before him at the time the invention was made, to modify the date field of Schwab to also include the time, as in Rogers, to obtain a date and time of purchase. One would have been motivated to make such a combination because the ability to better identify the purchase information would have been achieved, as taught by Rogers.

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As to claim 4, Schwab discloses, wherein the second information included in the purchase information further comprises information indicating a date of the deal 435 (see Figure 9).

As to claim 5, the difference between the claim and Schwab is the claim recites, further comprising: if the second sales information included in the received purchase information is not stored in said first storing part, extracting sales information containing the first information of the second sales information included in the purchase information from said first storing part; and, if the second information of the purchase information falls in a range from a minimum second information to a maximum second information that are contained in the extracted sales information, storing the purchase information as invalid purchase information in the second storing part. Rogers discloses a return validation method similar to that of Schwab. In addition, Rogers further teaches if the second sales information included in the received purchase information is not stored in said first storing part (if the purchase information is not identifiable), extracting sales information containing the first information of the second sales information included in the purchase information from said first storing part (extracting information of the actual merchant from the manufacturer database); and, if the second information (date of purchase) of the purchase information falls in a range from a minimum second information to a maximum second information (the minimum being 180 days, the maximum being any number over 180 days) that are contained in the extracted sales information, storing the purchase information as invalid purchase information (invalid corresponding to no possibility of return and non-warranty repair; col.9, ln.8-21; Figure 6) in the second storing part (any computer memory that stores/recognizes the electronic messages corresponding to the CSR options is a



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storing part). It would have been obvious to one of ordinary skill in the art, having the disclosures of Schwab and Rogers before him at the time the invention was made, to modify the method of Schwab to include extracting information, as in Rogers, to obtain a method of extracting return information. One would have been motivated to make such a combination because the ability to process returns from other retailers/merchants would have been achieved, and the ability to process returns without a receipt would also have been achieved, as taught by Rogers (col.8, ln.24-42). It should be noted that Schwab already discloses the use of return parameters to determine if a return is allowed or not, and these parameters can be the date parameters taught by Rogers (col.8, ln.40-60).

As to claim 9, Rogers teaches, wherein the second information included in the purchase information indicates a time order of deals made by the seller of the second commodity identified with the first information (see Figure 3).

As to claim 10, Rogers teaches, wherein said processing further comprises, extracting, when the second sales information included in the received purchase information is not stored, sales information containing the first information of the purchase information from said first storing part (extracts the information of the retailer who actually sold the item); storing, if the second information of the purchase information falls in a range from a minimum second information to a maximum second information (minimum being 180 days, maximum being infinity) that are contained in the extracted sales information, the purchase information as invalid purchase information (invalid meaning no return and non-warranty repair) in the second storing part (computer memory that receives/recognizes/displays the electronic messages is a storing part); and of storing, if the second information of the purchase information does not fall in the

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range, the purchase information as unidentified-validness purchase information in the second storing part (col.9, ln.8-21, Figure 5-6); if the second information is under 180 days but after 90 days, then the system sends purchase information that puts the item in unidentified-validness, or non-return but warranty repair in Rogers).

As to claim 13, Rogers teaches, further comprising, judging, when an equal comparison is not made, whether the second deal identifying information falls in a range from a minimum identifying second information to a maximum second identifying information that are stored in the first storing part (col.9, ln.8-21; Figures5-6).

As to claim 14, Rogers teaches, further comprising: storing, when it is judged that the second deal identifying information falls in a range (180 days or greater), the second deal identifying information together with an identifier for invalid information (message that shows CSR options; see Figure 6) in a second storing part.

As to claim 15, Rogers teaches, further comprising: storing, when it is judged that the second deal identifying information does not fall in the range (under 180 days, but after 90 days), the second deal identifying information together with an identifier for information whose validness is not identified (displaying the CSR options for non-return but warranty repair).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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1. US5367148 to Storch discloses a counterfeit detection method.
2. US5490060 to Malec discloses a passive data collection system.
3. US5857175 to Day discloses a system and method for offering discounts.
4. US5903878 to Talati discloses a method and apparatus for electronic commerce.
5. US5974396 to Anderson discloses a method and system for gathering consumer information.
6. US5979753 to Roslak discloses a device and method for secure data updates and self-checkout.
7. US6018719 to Rogers discloses an electronic registration system for product transactions.
8. US6049778 to Walker discloses a method and apparatus for administering a reward program.
9. US6055573 to Gardenswartz discloses communicating with a computer based on updated purchase behavior of a consumer.
10. US6154738 to Call discloses a method an apparatus for disseminating product information.
11. US6298330 to Gardenswartz discloses communicating with a computer based on the offline purchase history of a consumer.
12. US6484146 to Day discloses a system for offering targeted discounts to customers.
13. US6442276 to Doljack discloses verification of authenticity of goods by random numbers.

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14. US6519572 to Riordan discloses a method and system for collecting and processing data.

15. US20010034685 to Kutaragi discloses a selling price managing system and method therefore.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH



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